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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,034	11/21/2001	Erich Viechter	536733	9841
7590	07/13/2005		EXAMINER	
Thomas Langer, Esq. Cohen, Pontani, Lieberman & Pavane 551 Fifth Avenue, Suite 1210 New York, NY 10176			REID, CHERYL M	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/989,034	VIECHTER, ERICH	
	Examiner	Art Unit	
	Cheryl M. Reid	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 May 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2,3 and 5 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 2,3 and 5 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

1. Claims 2-3 and 5 have been examined.
2. Examiner has withdrawn objection pertaining to non-compliance with 35 U.S.C. 119(e). This objection was improperly applied and does not pertain to the present application.

Response to Arguments

3. Applicant's arguments with respect to the applicability of Satomi in regards to the present application have been considered but are moot in view of the new grounds of rejection.
4. Applicant's arguments with respect to motivation to combine Satomi with Ogle or Krishnan have been considered but are moot in view of the new ground(s) of rejection.
5. Applicant's arguments with respect to Ogle not teaching the limitations of claim 5, have been considered but are not persuasive. In particular, applicant states that independent claim 5 recites that the data is entered by the user of the terminal, namely the person who initiates a communication and states that this is in contrast to Ogle's teaching. This assertion is respectively traversed. Ogle teaches of an IM system that has an address book containing names of people with whom he/she wishes to communicate, wherein the names of people is the data entered by the user of the terminal. Examiner is interpreting data as any type of information entered by the user because this definition gives the broadest reasonable interpretation. It should be noted that although, Ogle did not explicitly state that the names/nicknames were entered by the user, this feature is well-known in the arts. It is well-known that a user of an IM

system has the capability to enter names or contact for those people with whom he/she wishes to communicate.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogle et al hereinafter Ogle (US 6430604).

8. In regards to claim 5, Ogle teaches of :

- A memory for storing data entered by the first person related to a plurality of other persons with whom the first person may wish to communicate (Col 1, lines 35-38), wherein the memory is the address book. It is well-known that a user of an IM system has the capability to create(enter) names or contact for those people with whom he/she wishes to communicate.
- Means for establishing a communication connection, via a designated one from among the plurality of means for communication, between the first person and

one of the plurality of other persons selected by the first person (Col 16, lines 19-30)

- Means for determining whether said selected other person could not be reached via the designated means for communication (Col 10, lines 65-67)
- Control means for designating another from among the plurality of specified means for communication when the selected other person could not be reached, and for actuating said means for establishing a communication connection with the selected other person via the other designated means for communication (Col 9, lines 27-42).

9. In regards to claim 3, Ogle teaches of the data stored in memory includes respective priority levels for the plurality of specified means of communication (Col 7, lines 30-40) wherein the priority levels are preferences.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle as applied to claim 5 above, and further in view of Labban (US 6574486).

12. In regards to claim 2, Ogle does not explicitly teach of memory that stores text messages to be forwarded with a suitable one from among the plurality of specified means of communication. Labban teaches of memory that stores text messages to be forwarded (Col 7, lines 50-54). It would have been obvious to one of ordinary skill in the art at the time of invention to utilize Labban's teaching of storing text messages because this would allow user's of Ogle's system to save messages that can only be delivered at certain time (Col 14, lines 20-25, Fig 5f1, item 710,715). Saving the messages would elevate the problem of having to re-create the message. One of ordinary skill in the art at the time of invention would be motivated to make the above-mentioned modifications because it would eliminate the disadvantage of a user having to re-create the message (additional key strokes) as suggested by Labban (col 1, lines 53-54).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl M. Reid whose telephone number is 571 272 3903. The examiner can normally be reached on Mon- Fri (7-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER

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